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10/726,534

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Yin-Chun Huang

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BERKELEY LAW & TECHNOLOGY GROUP, LLP
1700 NW 167TH PLACE
SUITE 240
BEAVERTON, OR 97006

EXAMINER

SINES, BRIAN J

ART UNIT

PAPER NUMBER

1743

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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3 MONTHS

04/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/726,534

Applicant(s)

HUANG ET AL.

Examiner

Brian J. Sines

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 13-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of group I comprising claims 1 – 12 in the reply filed on 1/11/2007 is acknowledged. Claims 13 – 17 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6 – 10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6 – 10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are:

Regarding claims 6 and 12, the applicant's specification indicates that the present invention incorporates a serially connected resistor with the chip device that imparts the improved measuring reliability feature to the device (see, e.g., p. 4, lines 15 – 22; p. 5, lines 10 – 25; p.6, lines 8 – 14). The incorporation of the serially connected resistor with the device appears to be a critical feature of the device. In claims drawn to an apparatus statutory class of invention, the structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative

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device (See MPEP § 2172.01). A feature that is indicated as critical to the invention in the specification should be recited in the claims (see MPEP § 2164.08c).

Claim Rejections - 35 USC § 102

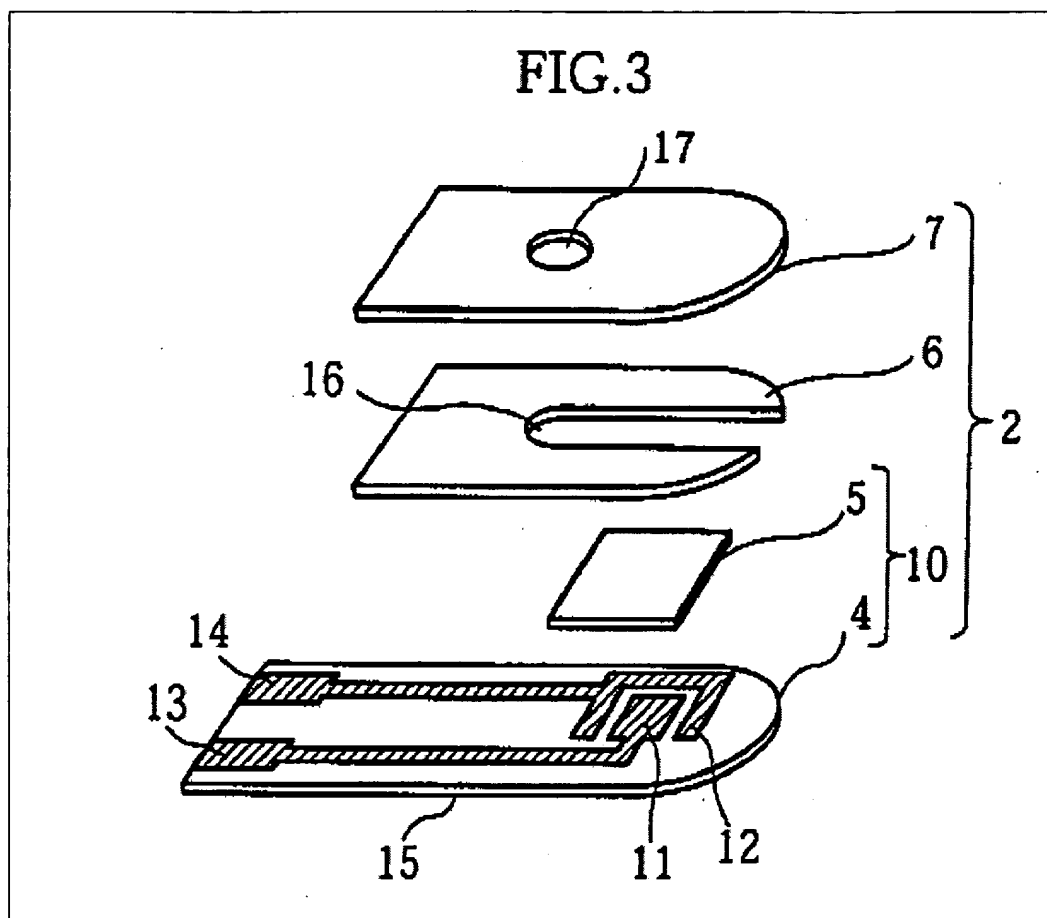
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1 – 5 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawanaka et al. (U.S. Pat. No. 6,349,230 B1)(“Kawanaka”).

Regarding claims 1 – 5 and 11, Kawanaka teaches a measuring instrument comprising: a chip 2 comprising a substrate 15 having various sections or areas of its top surface occupied by two lead terminals 13, 14, an operational electrode terminal 11 and a counterpart electrode terminal 12; a reaction layer 5; a spacer 6 having a slit passage 16 located above the reaction layer 5 comprising glucose oxidase and potassium ferricyanide; and a cover sheet 7 having an opening 17 (see, e.g., col. 4, lines 1 – 67; figure 3). The enzyme electrode section 10 of the chip 2 can be regarded as a resistor (see col. 5, lines 22 – 38). Apparatus claims must be structurally distinguishable from the prior art in terms of structure, not function. The manner of operating an apparatus does not differentiate an apparatus claim from the prior art, if the prior art apparatus teaches all of the structural limitations of the claim (see MPEP § 2114).



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

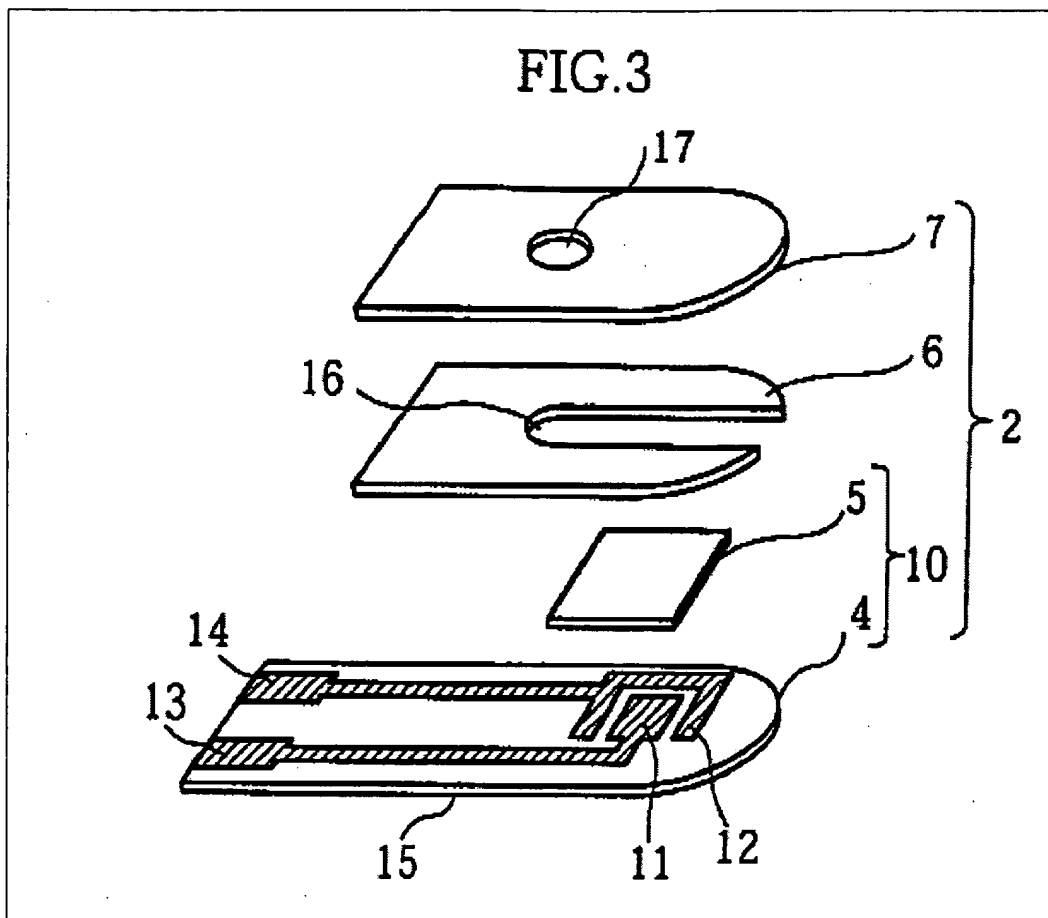
1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 6 – 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawanaka et al. (U.S. Pat. No. 6,349,230 B1)(“Kawanaka”) in view of Katsuki et al. (U.S. Pat. No. 6,916,410 B2)(“Katsuki”).

Regarding claims 6 – 10 and 12, Kawanaka teaches a measuring instrument comprising: a chip 2 comprising a substrate 15 having various sections or areas of its top surface occupied by two lead terminals 13, 14, a strip-like operational electrode terminal 11 and a strip-like counterpart electrode terminal 12; a reaction layer 5; a spacer 6 having a slit passage 16 located above the reaction layer 5 comprising glucose oxidase and potassium ferricyanide; and a cover sheet 7 having an opening 17 (see, e.g., col. 4, lines 1 – 67; figure 3). The enzyme electrode section 10 of the chip 2 can be regarded as a resistor (see col. 5, lines 22 – 38).



Kawanaka does not specifically teach the further incorporation of bent electrode configuration. Katsuki teaches a biosensor device having a bent electrode configuration (see, e.g., col. 7, lines 16 – 61). Furthermore, the change in form or shape, without any new or unexpected results, is an obvious engineering design. Therefore, it would have been obvious to a person of ordinary skill in the art to incorporate a bent electrode configuration as claimed with the disclosed measuring instrument.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additional cited prior art teach pertinent analytical devices.

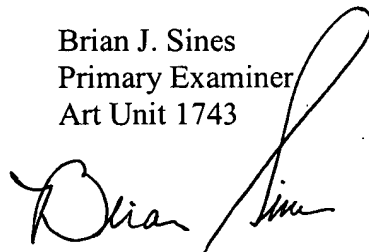
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Sines whose telephone number is (571) 272-1263. The examiner can normally be reached on Monday - Friday (11 AM - 8 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian J. Sines
Primary Examiner
Art Unit 1743

A handwritten signature in black ink, appearing to read "Brian Sines", is written over the printed name and title.